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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/826,227
Filing Date: April 16, 2004
Appellant(s): FANO ET AL.

Christopher P. Moreno
Reg. No. 38,566
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 01/16/2009 appealing from the Office action mailed 08/20/2008.

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(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

US 2003/0035648	Lopez-Estrada et al	8-2001
US 6,947,573	Linnartz	9-1998
US 5,410,326	Goldstein	12-1992

(9) Grounds of Rejection

The following grounds of rejections are applicable to the appealed claims:

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Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-7, 9-15, 25-26, 28-31, 34-35 and 38 are rejected under 35 U.S.C. 102(e) as being anticipated by Lopez-Estrada et al (US 2003/0035648).

Regarding Claims 1, 4 and 38, Lopez-Estrada discloses an apparatus with corresponding method for play back of multi-media program material comprising:

a multi-media playback unit, capable of selectively playing back segments of a multi-media program material (FIG.2C; element 30);

a memory wherein program instructions are stored to perform the function (Para 28);

a first controller, operatively coupled to said multi-media playback unit and to the memory (Para 28), said controller operable to cause the apparatus, when executing the program instructions to perform the functions of:

playing back from the multi-media program material, a first segment of the multi-media program material selected according to a first criteria that is defined according to content of the multi-media program material (Para 22 lines 1-8; Para 27 lines 6-10; playback a first segment based on a requested user's favorite chapter labels; a chapter label is defined according to content of the multi-media program material); and

suppressing playback of a second segment of the multi-media program material, based on the content of the at least one second segment selected according to a first criteria that is defined according to content of the multi-media program material (Para 22 lines 8-14; Para 23

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lines 22-30; skip a second segment if the segment is not the requested user's favorite chapter labels like commercial);

playing back from the multi-media program material, a third segment of the multi-media program material selected according to the first criteria (Para 22 lines 8-18; Para 27 lines 6-10; play a third segment if the segment is the requested user's favorite chapter labels).

Regarding Claims 2 and 3, Lopez-Estrada further discloses said first criteria and said second criteria are comprised of indexes within said multi-media program material that identifies a beginning of a segment (Para 22 lines 1-5; chapter label is an index identifying the beginning of a segment).

Regarding Claim 5, Lopez-Estrada further discloses said second segment is ordered after said first segment and said third segment is ordered after said second segment in said multi-media program material (Para 23 lines 22-30; scene 1 is first segment, commercial in between is second segment and scene 2 is third segment).

Regarding Claim 6, Lopez-Estrada further discloses the third segment is ahead of the first segment (Para 27; DVD inherently play preview, the second segment, before feature program; the segment after the second segment is the third segment).

Regarding Claim 7, Lopez-Estrada further discloses said first segment selected for playback includes a segment of video of a first portion of said multi-media program material and a segment of audio of a second portion of said multi-media program material (Para 16 lines 8-10).

Regarding Claim 9, Lopez-Estrada further discloses first criteria including a user's preferences to playback predetermined content (Para 27 lines 8-12).

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Regarding Claim 10, Lopez-Estrada further discloses said first criteria includes a user's specified playback time of said multi-media program material (Para 20 lines 1-4).

Regarding Claim 11, Lopez-Estrada further discloses viewing said multi-media program material;

identifying content segments in said multi-media program material that conform to at least one criteria (Para 20);

indexing said content segments by adding an index in said multi-media program (Para 20; segments identified as chapters).

Regarding Claim 12, Lopez-Estrada further discloses viewing said multi-media program material; and annotating said multi-media program material (Para 20).

Regarding Claim 13, Lopez-Estrada further discloses a user-specified time period, during which said multi-media program material is to be reviewed (Para 20 lines 1-4).

Regarding Claim 14, Lopez-Estrada further discloses the content for display is selected based on data embedded in said multi-media program material (Para 27).

Regarding Claim 15, Lopez-Estrada further discloses the content for display is selected based on data transmitted with said multi-media program material (FIG.2B).

Regarding Claims 25 and 26, Lopez-Estrada further discloses adding an annotation that that substantially contemporaneously describes information in said multi-media program material and is imbedded in the multi-media program (FIG.2B, element 22; Para 21 lines 10-17).

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Regarding Claims 28 and 29, Lopez-Estrada further discloses storing and transmitting said multi-media program material and said index on a storage media from which said program material can be played back and from which said annotation can be detected (FIG.2B; element 26; Para 26).

Regarding Claims 30 and 31, Lopez-Estrada further discloses detecting a viewer's input control signal to a multi-media playback device (FIG.2B, elements 23 and 24; Para 19);

adding a content segment to a first multi-media program in response to the user's input control signal and the added content segment is third party advertising content (Para 23 lines 22-30; add a commercial between 18 and 23 minutes into the program).

Regarding Claim 34, Lopez-Estrada further discloses suspending the display of said multi-media program on a display device; and displaying said content segment on said display device while the display of said multi-media program is suspended (Para 22 lines 22-30; the program is suspended when the commercial is played).

Regarding Claim 35, Lopez-Estrada further discloses transitioning play back of first and second segments of said multi-media program; and playing back said content segment between said first and second segments of said multi-media program (Para 23 lines 22-30).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 8, 18-19, 21 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lopez-Estrada et al (US 2003/0035648).

Regarding Claim 8, Lopez-Estrada discloses multi-media program material (Para 12) but not specifically about multi-media program material is comprised of at least one of a televised sporting event.

The Official Notice is taken that it is well known in the art that multi-media program material is comprised of at least one of a televised sporting event.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a televised sporting event as one of the most popular event for television.

Regarding Claims 18, 19 and 33, Applicant admits it is well known in the art to blend an overlay segment with a multi-media program (Specification Para 91).

Official Notice is also taken that it is well known in the art that the overlay segment is either semi-transparent or opaque.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include playing a multi-media program on a predetermined area of a display device with added content segment being presented substantially simultaneously with the display of said multi-media program.

Regarding Claim 21, Lopez-Estrada is silent about overlay content is determined by a user preference.

The Official Notice is taken that it is well known in the art to send a reminder or a message to a user to watch or record a program.

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5. Claims 16-17 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lopez-Estrada et al (US 2003/0035648) in view of Linnartz (US 6,947,573).

Regarding Claims 16-17 and 27, Lopez-Estrada is silent about identifying the owner of copyright and determining if requiring compensation.

In an analogous art, Linnartz discloses adding a watermark into a digital media stream to identify the owner of the copyright and trace illegal copies (Col 1 lines 16-24).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a watermark as taught by Linnartz with the added benefits of right protection and revenue increase.

6. Claims 32, 40 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lopez-Estrada et al (US 2003/0035648) in view of Goldstein (US 5,410,326).

Regarding Claims 32, 40 and 41, Lopez-Estrada is silent about a wireless controller capable of receiving information from said first controller and displaying content segment that contain third party advertising segments.

In an analogous art, Goldstein discloses a wireless controller capable of receiving information from said first controller and displaying content segment that contain third party advertising segments (FIG.6).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Lopez-Estrada's system to include a wireless controller capable of receiving information from said first controller and displaying content segment that contain third party advertising segments as taught by Goldstein with added convenience to use commonly used remote control.

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(10) Response to Argument***Appellant's Arguments***

a) The Appellant argues on pages 10-11 of Appeal Brief regarding Claims 1 and 38 that reference Lopez-Estrada fails to teach, disclose or suggest features of "playing back ... a first segment of the multi-media program material selected according to a first criteria that is defined according to the content of the multi-media program material", "suppressing playback of a second segment ... selected according to a second criteria that is defined according to the content of the multi-media program" and "playing back ... a third segment of the multi-media program material selected according to the first criteria". As best understood, Lopez- Estrada simply uses predefined criteria that is external to the MPEG stream and/or the content analysis module 43 (see e.g., FIG. 2D, lines 11-16 of paragraph [0023]), wherein such predefined criteria is not particular or customizable according the viewer's content interests or preferences. The Appellant further argues that as a result, the navigation points stored by the process of Lopez-Estrada have no ties to the semantic content of the MPEG streams and are instead tied to external criteria.

Examiner's Response

a) The Examiner respectfully disagrees with Appellant's arguments. Lopez-Estrada discloses a user can select a first segment of a multi-media program for playback based on a chapter which identifies the content of the program and the chapter itself is according to the content of the multi-media program material (Para 22 lines 1-8) and is not, as appellant argues, an external criteria. Meanwhile, selection for a particular chapter of a program for playback is also customizable according the viewer's content interests or preferences as evidenced by the capability provided to the end user to create a custom navigation file to go directly to favorite parts in a movie, parts that are identified by the user (Para 27 lines 8-10).

Appellant's Arguments

b) The Appellant further argues on pages 12-13 of Appeal Brief regarding Claims 1 and 38 that reference Lopez-Estrada fails to teach, disclose or suggest features "suppressing

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playback of a second segment ... selected according to a second criteria that is defined according to the content of the multi-media program" and merely locating segments to be read and played as disclosed in Lopez-Estrada does not correspond to "suppressing playback of a second segment... selected according to a second criteria that is defined according to the content of the multi-media program" as recited by Appellants in Claims 1 and 38.

Examiner's Response

b) The Examiner also disagrees with Appellant's arguments. Lopez-Estrada discloses a user can skip a second segment of a multi-media program for playback based on a chapter of a multi-media program which identifies the content of a program (by not selecting a particular chapter of a program); therefore, effectively discloses suppressing playback of a second segment ... selected, according to a second criteria that is defined according to the content of the multi-media program (by skipping a chapter).

(11) Related Proceeding(s) Appendix

No decision rendered by a court of the Board is identified by the examiner in the Related Appeals and interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

FHP

Conferees:

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